

REMARKS

Claims 21-38 are pending in the present application. Claims 1-20 are canceled. Claims 21-25 remain unamended. Claims 26-38 are added. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 103, Obviousness

The Office Action rejects claims 21-25 under 35 U.S.C. § 103 as being unpatentable over *Turek et al.* (US Patent No. 6,021,439) in view of *Rowley* (US Patent No. 5,999,740). This rejection is respectfully traversed.

With respect to claim 21, the Office Action states:

As per claims 1, 2, 4, 7, 10, 13, 15, 16, and 21, Turek teaches a method of communication and a computer program product in a computer-readable medium for providing control over information transmitted over the Internet in which data (see col.1, line 8: "QoS data") is transmitted over Internet connections from an Internet processor to Internet server or between an Internet processor and an Internet server over the Internet (see title: Fig.4; col.1, lines 6-9; and col.4, lines 28-37), the improvement of displaying a message to the user of said Internet processor, before any data is transmitted from the Internet processor over said Internet connection to an Internet server, a message, identifying at least one information element within the information, including an indication of the information or first information about to be transmitted from the Internet processor (see col.5, lines 36-42, 46-52, & 56-60; col.8, lines 5-10; and col.9, lines 57-61).

Although Turek does not teach about a cancel control for canceling the transmission, and allowing said user to cancel the transmission by selecting the cancel control (see col.6, line 66 to col.7, line 1), he does not explicitly teach of such a control included in a message. Rowley teaches about a cancel control for canceling the transmission, and allowing said user to cancel the transmission by selecting the cancel control included in the message (see col.5, lines 59-61). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Rowley within the system of Turek, by implementing a cancel button included in a message within the Internet communication method, because this immediately notifies the user that he/she has an option to cancel and the user has direct control for canceling the transmission.

Office Action, dated February 20, 2003. Applicant respectfully disagrees. *Turek* teaches an Internet quality-of-service (Q-o-S) method and system in which a Q-o-S-enabled web page is sent from a web site 50 to a web client 52. *Turek* states:

As is also illustrated in FIG. 4, a particular Web page 54 supported on the instrumented Web site 50 is identified as a page which the quality-of-service information will be collected. Such a page is referred to as an "Q-o-S enabled" page. A Q-o-S enabled page includes a token 55 (which may be an embedded markup tag, or the like) that serves several purposes. First, the token identifies the page to the Web client as a "Q-o-S enabled" page. This token, in effect, identifies the Web site's intent or desire to collect to some statistics about the nature of its quality-of-service. The token itself may also function as an "identifier" that is displayed, preferably together with the Web page, so that the user is thus made aware that such quality-of-service statistics are being collected. In this way, the identifier may represent a seal, certification or guarantee that the Web site operator is one that is concerned with and is attempting to address service problems that are experienced by the instrumented Web client.

Turek, col. 5, lines 28-45. Thus, *Turek* displays a "token" to the user that identifies that the web site **intends** to collect some statistics. There is no message in *Turek* that identifies information that is actually being collected.

Furthermore, *Turek* does not protect an Internet client from sensitive information from being collected. *Turek* attempts to solve this by allowing the Q-o-S-enabled web site to indicate that Q-o-S information is being collected anonymously. *Turek* states:

Thus, according to the present invention, a user of the 52 instrumented Web client is preferably notified that a given page is "Q-o-S enabled" by the display (e.g., in the form of a graphic element or text) of information that indicates that the Q-o-S statistics will be or are being collected with respect to that page. According to another feature of the invention, as will be further described, the Q-o-S statistics are preferably collected anonymously, i.e. without revealing the user's identity, clickstream or other personal information. Thus, the token may directly or indirectly provide an indication to the user of the instrumented Web client that the Q-o-S information is being collected and used by an instrumented Web server merely to address and rectify quality-of-service issues, and not for other reasons.

Turek, col. 5, lines 46-60. However, the Internet client is left to trust the web site not to collect sensitive information. In *Turek*, the client is only notified of the web site's **intent** to collect information when the site is first displayed. However, the client is not notified when information is sent from the client to the server. The client in *Turek* is also not aware of the content of the information being transmitted.

In contradistinction, the present invention provides a mechanism for generating a message that presents at least one information element being transmitted and a cancel control for canceling transmission. Claim 21 recites:

21. A method, in an Internet processor, for communicating over the Internet, the method comprising:
- responsive to receipt of a signal to transmit information from the Internet processor over an established Internet connection, identifying at least one information element within the information to be transmitted;
 - generating a message, wherein the message presents the at least one information element and includes a cancel control for canceling transmission; and
 - responsive to selection of the cancel control, canceling transmission of the information over the established Internet connection.

Thus, the present invention identifies at least one information element within the information to be transmitted **responsive to receipt of a signal to transmit information from the Internet processor over an established Internet connection**. The present invention also generates a message that **presents the at least one information element** and includes a **cancel control for canceling transmission**. *Turek* does not teach or suggest these features.

With respect to a "cancel control," the cited portion of *Turek* only teaches that the user may take some predetermined action, which would result in the data being sent to the server. The cited portion of *Turek* states:

At step 74, a test is performed to determine whether the user has taken a predetermined action (e.g., closed the browser, navigated to a new page, etc.). These actions are merely illustrative. If the outcome of the test at step 74 is negative, the routine cycles. If, however, the outcome of the test at step 74 indicates that the user has taken the predetermined action, the routine continues at step 76 with *the Web client uploading the collected information back onto the computer network*. Preferably, the collected quality-of-service information is uploaded without any

information identifying the user. This ends the client-side processing. [emphasis added]

Turek, col. 6, line 66, to col. 7, line 9. Thus, the cited portion of *Turek* teaches that the user cannot avoid transmission of the information by closing the browser, rather than teaching a “cancel control,” as alleged in the Office Action.

Rowley teaches an updating mechanism for software, wherein a server transmits software updates to a client. The cited portion of *Rowley* states:

Alternatively, the user may simply exit from the program without performing any updates by selecting the “Cancel” button.

Rowley, col. 5, lines 59-61. Thus, *Rowley* teaches a cancel control for canceling a transmission from a server to a client. *Rowley* does not teach or suggest “generating a message, wherein the message presents the at least one information element,” as recited in claim 21. The cited portion of *Rowley* teaches canceling an update; however, this update includes information to be transmitted **to** the Internet processor, rather than **from** the Internet processor, as in claim 21. The process in *Rowley* is actually the **opposite** process from that of the present invention. Furthermore, the process in *Rowley* does not address the problem being solved by the present invention, client privacy.

Turek and *Rowley*, taken alone or in combination, fail to teach or suggest each and every limitation of claim 21. Therefore, claim 21 cannot be rendered obvious by the combination of *Turek* and *Rowley*. Furthermore, there is no motivation or suggestion to combine the Q-o-S collection system of *Turek* with the separate and unrelated software update mechanism of *Rowley*. The Office Action may not use the claimed invention as an “instruction manual” or “template” to piece together the teachings of the prior art so that the invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of applicant's disclosure. *Id.* Therefore, absent some teaching, suggestion, or incentive in the prior art, *Turek* and *Rowley* cannot be properly combined to form the claimed invention. As a result, absent any teaching, suggestion, or incentive from the prior art to make the proposed combination, the presently claimed invention can be reached only

through the an impermissible use of hindsight with the benefit of Applicant's disclosure a model for the needed changes.

The present invention is directed towards notifying a user of information begin transmitted over an established Internet connection at the time of transmission. Even if *Turek* and *Rowley* could be properly combined, the combination would not form the presently invention recited in claim 21. Instead, a combination of *Turek* and *Rowley* would result in a web site that performs software updates on a client, informs the client of the **intent** to collect Q-o-S data, and collects Q-o-S data from the client.

Independent claims 27 and 33 recite subject matter addressed above with respect to claim 21 and are allowable for the same reasons. Since claims 22-26, 28-32, and 34-38 depend from claims 21, 27, and 33, the same distinctions between *Turek* and *Rowley* and the invention recited in claim 21 apply for these claims. Additionally, claims 22-26, 28-32, and 34-38 recite other additional combinations of features not suggested by the reference. Consequently, it is respectfully urged that the rejection of claims 21-25, as well as new claims 26-38 is overcome.

More particularly, with respect to claim 22 and new claims 28 and 34, the Office Action states:

As per claims 3, 6, 9, 12, 14, 20, and 22, *Turek* does not teach wherein said message further includes a selection control or a second selection control for selecting each information element to be transmitted. *Rowley* teaches wherein said message further includes a plurality of selection control for selecting each information element to be transmitted (see Fig.9 and col.5, lines 35-53). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of *Rowley* within the system of *Turek*, by implementing a selection control in the message within an Internet communication method, because this immediately notifies the user of additional option and controls that he/she can implement and allows the user to select the options according to his/her preference.

Office Action, dated February 20, 2003. Applicant respectfully disagrees. *Turek* and *Rowley*, taken alone or in combination, fail to teach or suggest “responsive to receipt of a signal to transmit information from the Internet processor over an established Internet connection, identifying at least one information element within the information to be transmitted” and “generating a message, wherein the message presents the at least one

information element and includes a cancel control for canceling transmission,” as recited in representative claim 21. Therefore, it follows that *Turek* and *Rowley*, taken alone or in combination, also fail to teach or suggest the further limitation of a selection control for each information element disclosed in the message.

As stated above, *Rowley* teaches canceling an update, which includes information to be transmitted **to** the Internet processor, rather than **from** the Internet processor, as in claim 21. The process in *Rowley* is actually the **opposite** process from that of the present invention. Furthermore, the process in *Rowley* does not address the problem being solved by the present invention, client privacy. Therefore, claims 22, 28, and 34 cannot be rendered obvious by a combination of *Turek* and *Rowley*.

With respect to claim 23 and new claims 29 and 35, the Office Action states:

As per claims 17 and 23, *Turek* does not teach wherein the first selection or each selection is selected by default. *Rowley* teaches wherein the first selection or each selection is selected by default. *Rowley* teaches wherein the first selection or each selection is selected by default (see col.5, lines 54-57). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of *Rowley* within the system of *Turek*, by implementing a default first selection in the message within an Internet communication method, because this enables the required information to be transmitted without the user having to select them, but rather giving the user only an option to cancel them.

Office Action, dated February 20, 2003. Applicant respectfully disagrees. *Turek* and *Rowley*, taken alone or in combination, fail to teach or suggest “a selection control for each information element disclosed in the message,” as recited in representative claim 22. Therefore, it follows that *Turek* and *Rowley*, taken alone or in combination, also fail to teach or suggest the further limitation of each selection control being selected by default.

As stated above, *Rowley* teaches canceling an update, which includes information to be transmitted **to** the Internet processor, rather than **from** the Internet processor, as in claim 21. The process in *Rowley* is actually the **opposite** process from that of the present invention. Furthermore, the process in *Rowley* does not address the problem being solved by the present invention, client privacy. Therefore, claims 23, 29, and 35 cannot be rendered obvious by a combination of *Turek* and *Rowley*.

With respect to claims 24, 25, and new claims 30, 31, 36, and 37, the Office Action states:

As per claims 18, 24, and 25, Turek does not teach of further comprising removing or blocking the first information item from the transmission before the information is transmitted responsive to deselection of the first selection control. Rowley teaches of removing or blocking the first information item from the transmission before the information is transmitted responsive to deselection of the first selection control (see Fig.9). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teaching of Rowley within the system of Turek, by removing selected item upon deselection from the selection control within an Internet communication method, because such limitation is well known in user defining options in all software applications and visibly notifies the user that a particular selection has been deselected.

Office Action, dated February 20, 2003. Applicant respectfully disagrees. *Turek* and *Rowley*, taken alone or in combination, fail to teach or suggest “a selection control for each information element disclosed in the message,” as recited in representative claim 22. Therefore, it follows that *Turek* and *Rowley*, taken alone or in combination, also fail to teach or suggest the further limitations of “responsive to deselection of a selection control, blocking transmission of the information element corresponding to the deselected selection control,” as recited in representative claim 24, and “responsive to manipulation of a selection control, blocking transmission of the information element corresponding to the selection control,” as recited in representative claim 25.

As stated above, *Rowley* teaches canceling an update, which includes information to be transmitted **to** the Internet processor, rather than **from** the Internet processor, as in claim 21. The process in *Rowley* is actually the **opposite** process from that of the present invention. Furthermore, the process in *Rowley* does not address the problem being solved by the present invention, client privacy. Therefore, claims 24, 25, 30, 31, 36, and 37 cannot be rendered obvious by a combination of *Turek* and *Rowley*.

With respect to claims 26, 32, and 38, the Office Action states:

Turek does not teach that the message includes an indication of an Internet address of the Internet server where the information is to be transferred. Rowley teaches that the message includes an indication of an Internet address of the Internet server where the information is to be transferred (see Fig.7 and col.4, lines 40-45). It would have been obvious

to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Rowley within the system of Turek, by implementing an Internet server address in the message within an Internet communication method, because this notifies the user what server at what location will be receiving the information. Turek also teaches that a user is notified by the display that a given web page (address) is QoS enabled and thereby will collection QoS statistic (see col.2, lines 18-22). Thus, one of ordinary skill in the art could simply perform the notifying within a message.

Office Action, dated February 20, 2003. Applicant respectfully disagrees. *Rowley* actually teaches a display that allows a user to select target server to which information may be uploaded. However, the cited portion in Fig. 7 and col. 4, lines 40-45, of *Rowley* actually refers to a different operation than the update canceling operation cited earlier in the Office Action, which comes at a different (and, in fact, far earlier) juncture in time. This is a clear sign that the rejection is based on a hindsight reconstruction of the claimed invention.

Furthermore, *Rowley* fails to teach or suggest displaying a message including an indication of the information to be transmitted from the Internet processor, "wherein the message presents the address of the Internet server to which the information is to be transmitted," as recited in claims 26, 32, and 38. Since the prior art, taken alone or in combination, fails to teach or suggest the claim limitations, claims 26, 32, and 38 cannot be rendered obvious by the combination of *Turek* and *Rowley*.

Therefore, the rejection of claims 21-38 under 35 U.S.C. § 103 is overcome.

II. Conclusion

It is respectfully urged that the subject application is patentable over *Turek* and *Rowley* and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: May 20, 2003

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'S. Tkacs', with a horizontal line drawn through it.

Stephen R. Tkacs
Reg. No. 46,430
Carstens, Yee & Cahoon, LLP
P.O. Box 802334
Dallas, TX 75380
(972) 367-2001
Agent for Applicants